

REMARKS/ARGUMENTS

Claims 1-25 are active in this application. The claims have been amended to remove inconsistencies in the definitions of R₈-R₁₇, by restricting the definition of Y₁ in each of these elements to those groups that do not contain any of R₈-R₁₇, and to limit the definition of Y₂ (renamed Y₂') in these elements to groups that do not contain any of R₈-R₁₇. These amendments are supported by the claims as originally filed and correspond to just a reduction of the members of the Markush Group originally included in those elements. No new matter has been added by these amendments.

The above amendments obviate the Examiner's rejection of various claims under 35 U.S.C. 112, second paragraph, by removing the circularity of the claim elements.

Claims 1-6 and 23 stand rejected under 35 U.S.C. 112, first paragraph. The Examiner has stated the specification teaches many diseases of different etiologies are related to the claimed method of binding a kappa opioid receptor, and according to the Examiner many of the listed diseases are not linked to the alleged activities. The question however, that the Examiner must answer is whether the specification provides sufficient description of a method of binding a kappa opioid receptor. The claims do not claim methods for treating a specific disease, but rather a method of binding a kappa opioid receptor. While Applicants have noted a number of different disease states believed to be related to kappa opioid receptor activity. It appears that the Examiner has also misinterpreted the language of the specification, as the text merely lists various activities of the present compounds, not all of which have to be present in each compound. The text does not say that the compounds are cytostatic agents that are used to treat diarrhea or anti-smoking agents to treat alcoholism. The treatment of alcoholism and the treatment of diarrhea are merely individual items in the list of how the compounds can be used, that also includes the use of compounds as cytostatic agents or anti-smoking agents. Applicants note that there is a comma present prior to each of

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the "to treat diarrhea" and "to treat alcoholism" phrases, thus indicating that they are not attached to the preceding indication, but are separate members of the list.

Applicants do not have to provide support for every suggested indication or activity of the present compounds. Applicants have provided support for how the present compounds are used as binders of kappa opioid receptors. Further, there is ample discussion in the specification (background section and description of the invention) of the relation of kappa opioid receptors to various disease states. Further, the claimed method is a method of binding kappa opioid receptors, which may result in treatment of one or more of the disease states indicated. However, it is not necessary for applicants to provide evidence that all of the recited disease states or conditions can be treated by the method. It is understood in the art that the various recited disease states, symptoms or conditions can be affected by kappa opioid receptors, and thus the present method of binding such receptors would be expected to ameliorate these disease states, symptoms or conditions. As such, the requirements of 35 U.S.C. 112, first paragraph are satisfied and the rejection should be withdrawn.

Applicants appreciate the Examiner's indication of allowability for claim 12, 18 and 22. Applicants believe that based upon the present amendment and comments above, all claims are now in condition for allowance.

Early notification to such effect is earnestly solicited.

Respectfully submitted,

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